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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,601	09/29/2003	Yousuke Yoneda	1419.1061C	8535
21171	7590	03/20/2006	EXAMINER	
STAAS & HALSEY LLP			LOWEN, ALYSSA	
SUITE 700				
1201 NEW YORK AVENUE, N.W.			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			3711	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/671,601	YONEDA, YOUSUKE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alyssa M. Lowen	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 September 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/29/03, 5/20/04, 8/26/04, 3/30/05 *31405*
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: IDS Paper No- 8/26/04, 3/30/05.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 9/29/03, 5/20/04, 8/26/04 and 3/30/05 are in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statements are being considered by the examiner.

### ***Priority***

2. Applicant's claim for the benefit of a prior-filed application (10/056110) under 35 U.S.C. 120 is acknowledged. Applicant has complied with the conditions for receiving the benefit of an earlier filing date.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim discloses a biasing member supported "laterally of a middle of a width direction of the wheel shaft" which is confusing and difficult to understand.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 16,18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Minato (1-172894). Minato discloses a suspension for a running toy (page 1 paragraph 2) having first and second turning members (23,24), which turn first and second wheels (27,28) about first and second shafts (23b, 24b) movably received by a chassis (20) of the toy (Fig. 3). A member (34) connects the first and second turning members and forms a turning device (page 9 paragraph 2). A leaf spring (36) located on the chassis contacts upper portions of the first and second shafts (Fig. 2) subjecting them to a downward biasing force caused by elastically deforming the leaf spring (page 11 second paragraph). Regarding claims 2 and 21 the suspension is for a remote control toy car (page 1 paragraph 2). In regard to claim 3 the leaf spring can be detached (Fig. 3). Regarding claim 4 the leaf spring comprises a projecting portion (37) at which the leaf spring is held on the chassis (Fig. 2). In regard to claim 5 the chassis contains a recess portion (38a, 38b,) in which the projecting portion of the leaf spring is held (Fig. 2). Regarding claim 6 the projecting portion of the leaf spring is sandwiched between the recess portion (38b) of the chassis and a shaft (34) connected to the chassis (Fig. 3). In regard to claim 16 the suspension further allows either wheel to move in a vertical direction while being biased by the biasing member or leaf spring (Fig. 4b). Regarding claim 18 the suspension includes two shafts each of which receives a portion of the biasing member (Fig. 2).

7. Claims 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Balthazor (3083499). Balthazor discloses a suspension for a toy vehicle having a

turning member attached to a chassis of the toy (Fig. 2) which includes two spaced wheels (18) and a turnable shaft (16) operatively connected to the wheels and a biasing member (34) that contacts the at least one shaft between the wheels (Fig. 2) exerting a downward force on the wheels (column 2 lines 59-65). The biasing member is connected to the chassis (Fig. 2) and allows either wheel to move in a vertical direction while being biased by the biasing member (column 2 lines 65-69). In regard to claim 19 the biasing member is a leaf spring (column 1 lines 41-42) and the leaf spring exerts the downward force on the shaft via bearings (44) extending between the leaf spring and the shaft (column 2 lines 55-58).

8. Claims 9,12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Perryman (GB1095490). Perryman discloses a toy car suspension having a wheel shaft (3) for attaching first and second wheels (4) and an elastically deformable biasing member or leaf spring (18) perpendicularly contacting a portion of the wheel shaft at an upper middle of the wheel shaft (Fig. 5). The wheel shaft is constructed to be movable vertically within a chassis in a predetermined range performing a seesaw motion by using the contact portion with the biasing member as a fulcrum, wherein the wheel shaft is biased at the contact portion by the biasing member in order to urge the first and second wheels in a downward direction (page 3 lines 4-14).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minato. Minato discloses the basic inventive concept substantially as claimed with the exception of the leaf spring and shaft being formed as a unitary member. It has been held that a one-piece construction instead of separate elements would be merely a matter of obvious engineering choice. See In re Fridolph 50 CCPA 745, 89 F.2d 509, 135 USPQ 319.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minato and Perryman (GB 1095490). Minato discloses the basic inventive concept substantially as claimed with the exception of the leaf spring being made of metal or plastic. Perryman discloses a leaf spring used in the suspension system of a toy car made of metal or steel (page 2 lines 122-129). It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Perryman to use metal or plastic in a leaf spring since it is elastically deformable and is usable as a biasing member. Furthermore, the mere selection of known materials such as metal and plastic on the basis of suitability for the intended use would be entirely obvious.

See in re Leshin, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide Minato with metal or plastic in order to use known materials suitable for the intended use.

12. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perryman and Minato. Perryman discloses the basic inventive concept as applied to claims 9 and 12 above with the exception of the toy vehicle being a running toy.

Minato discloses a running toy with a suspension system (page 1 paragraph 2). It would have been obvious to one of ordinary skill in the art from the teaching of Minato to put a suspension system in a running toy since a running toy would provide more amusement and entertainment value to a child since the toy would move without being touched.

13. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perryman and Balthazor. Perryman discloses the basic inventive concept as applied to claims 9 and 12 above with the exception of the biasing member being detachable. Balthazor discloses a detachable biasing member being used in the suspension system of a toy vehicle (column 1 lines 44-47). It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Balthazor to have a detachable biasing element in order to make the element easily removable should the part need to be replaced.

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perryman and Sano (5141209). Perryman discloses the basic inventive concept substantially as claimed in claim 12 with the exception of the leaf spring being connected to the wheel shaft by a roller bearing. Sano discloses a suspension system with a leaf spring (11) attached to an axle (55) by a roller bearing (53). It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Sano to connect the wheel shaft and leaf spring using a roller bearing so that the axle is able to spin freely without the spring hindering its performance with direct contact.

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15. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minato and Perryman. Minato discloses a running toy with a suspension as claimed in claim 18 and further comprising a tie rod (34) connecting each of the shafts (Fig. 3). Minato does not disclose the tie rod being urged downward by a second leaf spring extending between the chassis and tie rod. However, Perryman discloses a resilient strip-shaped portion (11) attached to a tie rod (10), which connects the wheel shafts (Fig. 5). It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Perryman to have a leaf spring connected to the tie rod in order to maintain the axles in a perpendicular configuration to the length of the toy while it is being steered (page 3 lines 53-61).

#### ***Double Patenting***

16. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

17. Claims 9-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 8-10 of prior U.S. Patent No. 6656011. This is a double patenting rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AML



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PRIMARY EXAMINER